

SK



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/364,794	07/30/99	BERGE	J 7480-PA1CP2

PM92/0420

JAMES W MCLAIN
BROWN MARTIN HALLER & MCCLAIN LLP
1660 UNION STREET
SAN DIEGO CA 92101

EXAMINER

SHAPIRO, J

ART UNIT

PAPER NUMBER

3651

DATE MAILED:

04/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/364,794

Applicant(s)

BERGE ET AL.

Examiner

Jeffrey A. Shapiro

Art Unit

3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-163 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-163 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☐ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 17) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____

Art Unit: 3651

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-163 are rejected under 35 U.S.C. 112, second paragraph, in view 37 C.F.R. 1.75(b), on the grounds of multiplicity and prolix. It has been held that the presentation of a large number of claims may pose a burden to the PTO and the courts, not justified by the extent of Applicants' interest in latitude in claiming the invention. (Applicant's latitude in stating their claims in regard to number and phraseology employed "should not be extended to sanction that degree of repetition and multiplicity which beclouds definition in a maze confusion."). *In re Chandler*, 117 USPQ 361 (CCPA 1958). See also MPEP 2173.05(n).

Regarding prolix, "claims are rejected as prolix when they contain long recitations or unimportant details which hide or obscure the invention. *Ex parte Iagan*, 1911 C.D. 10, 162 O.G. 538 (Comm'r Pat. 1910). See also MPEP 2173.05(m). The application as filed contains one-hundred-and-sixty-three claims. For example, note that Claim 120 claims second port pairs comprising at least four second port pairs. Claim 123 claims second port pairs comprising two, three or four second port pairs. Claims 28 and 30 both claim an ice receptacle that is vertically aligned. Claim 30 states as follows.

Apparatus as in Claim 29 wherein said accumulator and said ice receptacle are generally vertically aligned with said accumulator above said ice receptacle such that deposit of said accumulated ice discharged from said accumulator into said ice receptacle comprises said ice being dropped under the influence of gravity.

Art Unit: 3651

All of these claims are just some of the numerous examples of claims exhibiting multiplicity and prolix. Regarding Claim 29, it is understood that when ice is dropped, it falls under the influence of gravity. Claims 120 and 123 appear to claim the same thing. These themes appear to run throughout the Applicant's claims.

Examiner notes that both related co-pending applications 09/207,075 and 09/128,050 recite similar subject matter and read on the claims of this application. These other applications are further evidence of undue multiplicity.

While the Examiner does not take the position that applicants should be precluded from submitting claims defining their invention, the number originally filed is in excess of a reasonable number with which to claim the invention.

Particularly in the context of 37 C.F.R. 1.75 and the cited opinions, rejection on the grounds of prolix and multiplicity is appropriate.

Even though the rejection may be traversed, applicant is required in response to this action to designate no more than either

- (1) a total of ten claims including up to four independent claims, or
- (2) a total of twenty claims including up to two independent claims, for reexamination on the merits.

Considering the cited references, it is noted that the average number of claims patented is 1.75 independent claims and 16.875 total claims. Therefore, the designation of up to the indicated numbers of claims affords applicant ample latitude in claiming the invention, is reasonable in view of the state of the art and the nature of the

Art Unit: 3651

invention as well as considering the stage of prosecution and the number of claims originally presented and examined, and is necessary to permit a complete examination without the imposition of serious burden on the Office.

Applicants' are advised that should they wish to traverse and the rejection previously outlined, that in addition to pointing out alleged errors in the multiplicity/prolix rejection, reasons for traversal should also be addressed.

Applicant is advised that should it be traversed and repeated, this is an *appealable* ground of rejection.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher P. Ellis can be reached on (703)308-0552. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-0552 for regular communications and (703)308-0552 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Art Unit: 3651

A handwritten signature in black ink, appearing to read 'Jeffrey A. Shapiro', written in a cursive style.

Jeffrey A. Shapiro
Patent Examiner,
Art Unit 3651

April 18, 2000

A handwritten signature in black ink, appearing to read 'Christopher P. Ellis', written in a cursive style.

CHRISTOPHER P. ELLIS
PRIMARY EXAMINER